

Remarks

Claims 84-113 are pending in this Application; claims 86, 90-98, 102, 104, and 108-110 have been withdrawn.

The specification has been amended to indicate the current status of the priority applications

Claims 84 and 89 have been amended to incorporate the limitations of claims 87 and 103, respectively. Claims 87 and 103 have been cancelled. Note that the added language in claims 84 and 89 has amended the original language from claims 87 and 103 to clarify that the antibody is one "that binds to" an epitope. Support for these claim amendments can be found throughout the specification, for example at page 9, line 30.

Claims 84 and 87 have also been amended to clarify that IGFR is IGFR-1. Support for these amendments can be found throughout the specification (see, e.g., page 25, lines 3-4).

None of the above amendments adds any new matter to the Application as filed.

Each of the objections and rejections raised in the Office Action is addressed separately below.

Specification

The specification has been objected to because it does not reflect the most current status of the priority applications to the Application.

Applicants have overcome this ground for objection with the present amendments to the specification.

Claims

(i) Rejection under 35 U.S.C. §112, second paragraph

Claims 87 and 103 stand rejected under 35 U.S.C. §112, second paragraph, because the phrase "specific for" allegedly renders the claims indefinite.

Applicants respectfully aver that ample support for the definition of "specific for" can be found throughout the specification. However, for the sake of facilitating prosecution, Applicants have overcome this ground for rejection by amending the language of claims 87 and 103 (as incorporated into claims 84 and 89, respectively) as suggested by the Examiner in the Office Action.

Claims 100 and 111 stand rejected under 35 U.S.C. §112, second paragraph, as being allegedly indefinite because the claims recite the term “rhuMab Her2”, and it is unclear from the specification if rhuMab Her2 and Herceptin® are one and the same.

Applicants respectfully aver that rhuMab Her2 and Herceptin® are indeed one and the same. See, for example, the specification at page 15, lines 21 where it states “rhuMab HER2, otherwise known as HERCEPTIN®”.

Based on these remarks, Applicants respectfully request that this ground for rejection be reconsidered and withdrawn.

(ii) Rejection under 35 U.S.C. §112, second paragraph

Claims 84, 85, 87-89, 99-101, 103, 105-107, 111-113 stand rejected under 35 U.S.C. §112, first paragraph, for allegedly failing to comply with the enablement requirement.

Applicants have overcome this ground for rejection with the present amendments to claims 84 and 89.

As stated in the Office Action at page 10, the specification provides guidance and examples for predictably identifying treatment outcome to Herceptin® therapy based on phosphorylation of SEQ ID NO: 2 at residue 235. As the claims now recite this site of phosphorylation, this ground for rejection as it pertains to the phosphorylation of S6 ribosomal polypeptide has been overcome.

As to this ground for rejection as it pertains to IGFR, Applicants clarify that IGFR is indeed IGFR-1 (see amended claims 84 and 89).

Based upon these remarks, Applicants respectfully request that this ground for rejection be reconsidered and withdrawn.

APPLICANTS: Bacus, et al
U.S.S.N.: 10/735,118

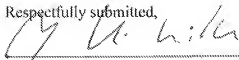
CONCLUSION

Applicants respectfully believe the elected claims are in condition for allowance, and so further and favorable consideration on the merits of the claims of record is respectfully requested.

A petition for a three (3) month extension of time is hereby made to respond to the Office Action mailed on April 2, 2009. The Commissioner is hereby authorized to charge the fee required by 37 C.F.R. §1.17, as well as any additional fees that may be due, or credit any overpayment of same, to Deposit Account No. 50-1774, Reference No. CST-213. With the extension, this Response is due on or before October 2, 2009.

If there are any questions regarding this filing, the Examiner is kindly requested to contact the undersigned at the telephone number indicated below.

Respectfully submitted,



Nancy Chiu Wilker, Reg. No. 43,545
Attorney for Applicant
CELL SIGNALING TECHNOLOGY, INC.
(978) 826-6019